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No. 1181

In The

Supreme Court of the United States

October Term 1967

CHESTER WAGNER, an individual, and
HENNY PENNY CORPORATION,
Petitioners,

v.

BALLANTYNE INSTRUMENTS & ELECTRONICS, INC.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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INDEX

	Page
Opinions Below	1
Jurisdiction	2
Questions Presented	2
Statutes Involved	2
Statement of Facts	3
Reasons for Granting the Writ	8
Conclusion	15
Appendix A—Opinion Below	17
Appendix B—Entry of Judgment	20

TABLE OF CITATIONS

CASES:

Abington Textile Works v. Carding Specialties Ltd., 249 F. Supp. 823 ..... 13, 14

American Photocopy Equipment Co. v. Rovico, Inc., 257 F. Supp. 192 13

Borg-Warner Corp. v. Paragon Gear Works, Inc., 355 F.2d 400, pet. for cert. filed March 23, 1966, dismissed May 13, 1966 14-15

Cheiten v. Hancock-Gross Inc., 234 F. Supp. 717 13

Emerson v. National Cylinder Gas Co., 135 F. Supp. 268 13

Exhibit Supply Co. v. Ace Patents Corp., 315 U.S. 126 10

Graver Tank Mfg. Co. v. Linde Air Products Co., 339 U.S. 605, reh. den. 340 U.S. 845 8-10

Hunt Tool Co. v. Lawrence, 242 F.2d 347, cert. den. 354 U.S. 910 12

McCullough Tool Co. v. Well Surveys, Inc., 343 F. 2d 381 12

Powder Power Tool Corp. v. Powder Actuated Tool Co., 230 F.2d 409 12

Page

Ritter v. Rohm & Haas Co., 154 U.S.P.Q. 518 14
Waterproof Insulation Corp. v. Insulating Concrete Corp., 153 F. Supp. 626 13

STATUTES:

28 U.S.C. 1254(1) 2
28 U.S.C. 1338 3
28 U.S.C. 2201 3
28 U.S.C. 2202 3
35 U.S.C. 112 ..... 2, 8
35 U.S.C. 271(a) and (b) 2

OTHER AUTHORITIES:

The Law of Chemical, Metallurgical and Pharmaceutical Patents 15-16

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v.

BALLANTYNE INSTRUMENTS & ELECTRONICS, INC.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

Chester Wagner and Henny Penny Corp., your petitioners, pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Sixth Circuit, entered in the above entitled case on December 7, 1967.

OPINION BELOW

The opinion of the United States District Court for the Southern District of Ohio is reported at 260 F. Supp. 540. The opinion of the United States Court of Appeals for the Sixth Circuit has not been reported but is reprinted herein. (Appendix A, *infra*)

JURISDICTION

The judgment of the court of appeals affirming the district court's opinion was entered on December 7, 1967. (Appendix B, *infra*) No rehearing was sought. Jurisdiction of this Court is invoked under 28 U.S.C. § 1254 (1).

QUESTIONS PRESENTED

(a) Whether a patentee should be denied the benefit of the doctrine of equivalents because he has complied with the statutory requirement of distinctly claiming his invention.

(b) Whether the doctrine of file wrapper estoppel should be applied and a patentee denied the benefit of the doctrine of equivalents where the language of his patent claim was modified during the prosecution of his patent application to overcome the Patent Office's rejection that the claim failed to define the applicant's invention.

STATUTES INVOLVED

Section 112 of Title 35 of the United States Code provides in pertinent part:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Section 271 of Title 35 of the United States Code provides in pertinent part:

> § 271. Infringement of patent
>
> (a) Except as otherwise provided in the title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.
>
> (b) Whoever actively induces infringement of a patent shall be liable as an infringer.

STATEMENT OF FACTS

Ballantyne Instruments & Electronics, Inc. (respondent) filed a declaratory judgment action on December 13, 1961 against Chester Wagner (petitioner) requesting the court to hold Wagner patent No. 2,778,736 invalid and not infringed. Jurisdiction was claimed under 28 U.S.C. 1338, 28 U.S.C. 2201, and 28 U.S.C. 2202. Henny Penny Corporation (petitioner) was also joined as a defendant since it was licensed under the Wagner patent. Defendants counterclaimed, alleging that Ballantyne had infringed the Wagner patent and that it was valid.

On February 14, 1964, the district court granted Ballantyne's motion for summary judgment and held all three claims of the Wagner patent invalid in view of a publication written by Nola Treat and Lenore Richards entitled "Quantity Cookery". 227 F. Supp. 394. Wagner appealed this decision to the Sixth Circuit Court of Appeals. On May 13, 1965, the Court reversed the district court's decision insofar as it held Claims 2 and 3 invalid. 345 F.3d 671.

The case was tried before the district court on April 20 and 21, 1966. On July 20, 1966, the Court rendered its decision, holding Claims 2 and 3 valid and not infringed. On August 16, 1966, Wagner appealed from the finding of noninfringement. Ballantyne filed a cross appeal as to the Court's finding of validity. On December 7, 1967, the Court of Appeals affirmed the district court's opinion, relying on the reasons and the law set forth in the lower court's decision.

The Prior Art of Frying and the Patented Wagner Method of Deep Fat Pressure Frying

At the time of Wagner's invention in 1954, there were three principal ways to fry foods, and chicken in particular. The oldest one of course was to fry the chicken in an

ordinary frying pan on top of a stove. In some instances, the last few minutes of the cooking was done by baking the chicken in an oven. (204ja) * The second method was to fry the chicken while it was completely immersed in oil in an open, deep fat fryer. (185ja) The third method, detailed in "Quantity Cookery", *supra,* consisted of frying the chicken for several minutes in a deep bath of hot oil and then pressure cooking it at a temperature of about 250° F. (172ja) This is the method made famous by Colonel Sanders. (47ja)

For one reason or another these three methods were not entirely satisfactory for a commercial operation in that they either took a great deal of time, required constant supervision, the results were not reproducible or the product was grease logged. (185ja; 173ja)

In 1954, Mr. Chester Wagner invented a new method for frying food, a method whereby the food was fried at a sustained temperature of 325° F. while it was maintained under a pressure of about 15 pounds. (173ja) Although chicken is the major food on which the process is now practiced commercially, many other items can be fried according to the method. (305ja) For instance, potatoes, fish, carrots, oysters, scallops, short ribs, etc. can also be pressure fried. The method is described in detail in the Wagner patent and is covered by Claims 2 and 3 thereof. Briefly, his method as claimed in Claim 2 consists of the following steps: (171-172ja)

(1) Heating a bath of oil to about 310° F.

(2) Introducing the food to be cooked in the bath of hot oil and allowing it to cook for "a time sufficient to brown the food."

---

* Wagner, Henny Penny and Ballantyne filed a joint appendix in the Court of Appeals.

(3) Enclosing the food and continuing the frying at a temperature of about 310 to 325° F. while simultaneously maintaining a pressure of up to about 15 pounds to square inch and,

(4) Continuing the frying from five to seven minutes.

Claim 3 is similar to Claim 2 except it recites in lieu of step two that the food be cooked for 2 to 3 minutes prior to applying pressure. It also includes the additional step of completing the cooking cycle in approximately 10 minutes. (172ja)

The district court found that Wagner was the first person to practice this process. The court stated that:

> The methods claimed in Claims 2 and 3 of the Wagner patent 2,778,736 are the first disclosure in the art of a method of pressure frying chicken in which the chicken is maintained at a constant heat and a uniform pressure throughout the entire cooking cycle. (173ja)

The court also found that chicken cooked in accordance with the Wagner method was physically different from chicken cooked in accordance with the "Quantity Cookery" recipe, *supra,* in that the Wagner chicken had a deeper brown color, a crisper exterior and contains substantially less absorbed fat. (173ja)

The specification of the Wagner patent lists the following advantages of the Wagner method over the previous prior art methods of frying: (185-189ja)

(1) Control of the factors responsible for producing a quality product.
(2) Less shrinkage of food.
(3) Quicker.
(4) Superior product.
(5) Less fat consumption.

The Wagner method of deep fat pressure frying became an almost immediate success for Mr. Wagner and for his success he received the Feature Product Award of the Institutional Feeding and Housing Magazine. (329ja) It has been a success not only for Mr. Wagner and the Henny Penny Corporation, but also for Ballantyne. In the period from 1961 to 1963, Ballantyne sold approximately 2,000 of its "Flavor Crisp" deep fat pressure fryers. (323ja) When it is considered that each machine is capable of providing for its user a profit of $58.32 an hour, is it no wonder that so many pressure fryers have been sold? (325ja)

To support their charges that Ballantyne induced its users to use its pressure fryer in such a way that the Wagner patent was infringed, Wagner and Henny Penny relied principally upon the evidence presented at the trial by Ballantyne. The only real question as to whether Claims 2 and 3 were infringed was whether Ballantyne recommended the following step of Claim 2:

> introducing the food to be cooked into said hot bath of oil and cooking the same for a time sufficient to brown the food.

or the following step of Claim 3:

> Introducing the food to be cooked into said hot bath of oil and cooking it for from two to three minutes.

This step is the so-called "preliminary pre-cooking step." It precedes the step of pressure frying the food. It is old in the art, taught by the "Quantity Cookery" article, *supra*.

Ballantyne contended that the process that it instructed the users of its Flavor Crisp apparatus to use did not include the pre-cooking step, that instead of recommending this step it instructed its users to load the food *piece-by-piece* and *thereafter immediately* begin the pressure frying step.

Wagner and Henny Penny contended that this constituted a literal infringement of Claims 2 and 3 because some of the pieces of chicken placed into the fryer received the pre-cooking step even if the last one did not; but that even if there was no literal infringement, a case of infringement had been proved because the processes were legal equivalents since they operated in substantially the same way to give the same results.

The district court reviewed the file history of the Wagner patent and concluded that Wagner could not contend that the process Ballantyne instructed its customers to use was the legal equivalent of the patented process, because Wagner, by reason of the doctrine of file wrapper estoppel, was estopped from doing so.

The court made two crucial findings to support its holding.

> 16. When Chester Wagner first filed his patent application in the Patent Office, he disclosed a cooking method which included both a preliminary browning step with the container open and a final pressure cooking step with the container closed. Wagner's application claims which were not limited to this particular cooking process were rejected as unpatentable over the prior art and as not commensurate with Wagner's disclosure. In the Patent Office Action of November 1, 1956, the Patent Examiner held:
>
> > "Claims 22-24 are rejected as failing to define applicant's process since they do (not) recite the initial step of partially cooking the food in hot oil for a period of 2-3 minutes before enclosing the food and continuing the cooking of the food under pressure while the food is maintained in the bath of hot oil. It is axiomatic that the claims must be commensurate in scope with the disclosure."
>
> 17. In response to the Patent Office rejection, Wagner cancelled the rejected claims and presented three

> new application claims which became Claims 1, 2 and 3 of the issued patent. Each of these new claims include the preliminary browning step as a material limitation which was necessary to overcome the rejection and to induce the allowance of the claims. Wagner is now estopped to ignore or eliminate the preliminary browning step from patent Claims 2 and 3 since to do so would make these claims the same as the rejected claims which were cancelled and abandoned. (174ja)

It can be seen from the Examiner's statement in finding 16 that the claims were rejected as being indefinite, a rejection based on 35 U.S.C. 112. The rejection was *not* based on the prior art.

REASONS FOR GRANTING THE WRIT

The writ should be granted so that conflicting decisions of different United States Courts of Appeals and different Federal District Courts on an important question of patent law can be resolved.

In *Graver Tank & Mfg. Co., Inc.* v. *Linde Air Products Co.*, 339 U.S. 605 (1950), reh. den. 340 U.S. 845, the question of what constituted a patent infringement was before the Court. It held that in order to determine whether a patent was infringed

> resort must be had in the first instance to the words of the claim. If accused matter falls clearly within the claim, infringement is made out and that is the end of it. 339 U.S. at 607

The district court in the instant case concluded that the accused Ballantyne process did not fall within the literal language of the claims.

The Supreme Court recognized in the *Graver* case, however, that to permit an infringer to escape liability by subtle

and meaningless modifications would render the "patent grant a hollow and useless thing." The Court stated:

> But courts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for—indeed encourage—the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law. One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system. 339 U.S. at 607.

The doctrine of equivalents evolved to prevent such pirating.

> The doctrine of equivalents evolved in response to this experience. The essence of the doctrine is that one may not practice a fraud on a patent. Originating almost a century ago in the case of Winans v. Denmead, 15 How. 330, 14 L.Ed. 717, it has been consistently applied by this Court and the lower federal courts, and continues today ready and available for utilization when the proper circumstances for its application arise. "To temper unsparing logic and prevent an infringer from stealing the benefit of the invention" a patentee may invoke this doctrine to proceed against the producer of a device "if it performs substantially the same

> function in substantially the same way to obtain the same result." Sanitary Refrigerator Co. v. Winters, 280 U.S. 30, 42, 50 S. Ct. 9, 13, 74 L. Ed. 147. The theory on which it is founded is that "if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form or shape." Union Paper-Bag Machine Co. v. Murphy, 97 U.S. 120, 125, 25 L. Ed. 935. 339 U.S. at 608.

The doctrine may be applied to improvement or secondary inventions as well as to pioneer inventions. 339 U.S. at 608.

The doctrine is not applicable where the patentee has, through his conduct in the Patent Office in attempting to distinguish the prior art, estopped himself from contending that one thing is the equivalent of another. This is the so-called "doctrine of file wrapper estoppel." It was recognized and applied by the Court in *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U.S. 126 (1942). There the Court stated:

> Assuming that the patentee would have been entitled to equivalents embracing the accused devices had he originally claimed a "conductor means embedded in the table", a very different issue is presented *when the applicant in order to meet objections in the Patent Office, based on references to the prior art, adopted the phrase as a substitute for the broader one "carried by the table"*. Had Claim 7 been allowed in its original form it would have read upon all the accused devices since in all the conductor means complementary to the coil spring are "carried by the table". By striking that phrase from the claim and substituting for it "embedded in the table" the applicant restricted his claim to those combinations in which the conductor means, though carried on the table, is also embedded in it. By the amendment he recognized and emphasized the difference between the two phrases and pro-

> claimed his abandonment of all that is embraced in that difference. . . . 315 U.S. 136 (emphasis ours)

The factual situation in the Exhibit case which gave rise to the application of the doctrine of file wrapper estoppel is considerably different from the one in the instant case. In the Exhibit case the patentee amended his claim in *order to distinguish the prior art cited by the Patent Office.* Had he not amended it, the article defined by it would have been unpatentable over the prior art. Afterwards, in litigation, he sought to enforce his patent against an infringer. However, in order to establish that the defendant was infringing he had to expand the scope of the claims. But, the scope which he was urging in court he had abandoned in the Patent Office by amendment. To allow this construction would have been to permit the patentee to recapture what the Patent Office required him to give up. In contrast to this is the situation which confronted Mr. Wagner. No prior art was cited by the Patent Office against his claims when the amendments in question were made. Instead, the examiner stated that Mr. Wagner had failed to distinctly and particularly claim his invention and that the claims were indefinite. The examiner pointed out that the rejection "is merely technical in character in that the proper amendment of the same would place this case in condition for allowance." (216ja) This is not the situation presented in the Exhibit case. To apply the file wrapper estoppel doctrine in this situation is to penalize the applicant for what he was required by statute to do, to distinctly claim the invention disclosed in his application.

The Supreme Court has not considered whether the file wrapper estoppel doctrine is applicable when the amendment was made to meet an indefiniteness rejection.

Several lower courts have considered the question and

as a result there is a conflict between the decisions of several courts of appeals and of several district courts.

In the recent case of *McCullough Tool Co.* v. *Well Surveys, Inc.*, 343 F.2d 381 (1965) the Tenth Circuit Court of Appeals considered this same question and held that there was no estoppel.

> McCullough next asserts that Swift is limited to an interrupted signal system and one pen recorder by virtue of the doctrine of file-wrapper estoppel. *However, the essence of the doctrine is that a patentee may not expand his allowed claims by interpretation to embrace features which he disclaimed in order to overcome objections by the Patent Office on the basis of prior art disclosures.* Doran Coffee Roasting Co. v. Wyott Manufacturing Co., supra. It is *not applicable where the patentee's difficulty results not from the wording and indefiniteness of the claims.* Sears, Roebuck & Co. v. Jones, supra. *In this case, the original claims upon which McCullough relies to invoke the doctrine were not rejected because they were unpatentable over the prior art. They were rejected on the formal grounds of being improper method claims and therefore file-wrapper estoppel is not applicable.* 343 F.2d at 403 (emphasis added)

In *Powder Power Tool Corp.* v. *Powder Actuated Tool Co.*, 230 F.2d 409 (1956), the Court of Appeals for the Seventh Circuit considered the same question and *held that the doctrine was applicable.*

The Sixth Circuit by affirming the decision of the district court in this case, has now chosen to align itself with the Seventh Circuit.

It is submitted that the Fifth Circuit aligned itself with the Tenth Circuit by its decision in *Hunt Tool Co.* v. *Lawrence*, 242 F.2d 347 (5th Cir. 1957) cert. den. 354 U.S. 910. The result of that decision is that a patentee is

permitted to expand a claim he amended to avoid the prior art so long as the expanded claims do not read on the prior art.

The following federal district courts have chosen to follow the rule enunciated by the Tenth Circuit Court of Appeals; *Abington Textile Work* v. *Carding Specialties Ltd.*, 249 F. Supp. 823 (D.D.C. 1965); *American Photocopy Equipment Co.* v. *Rovico, Inc.*, 257 F. Supp. 192 (N.D. Ill. 1966); *Cheiten* v. *Hancock-Gross Inc.*, 234 F. Supp. 717 (E.D. Pa. 1964); *Waterproof Insulation Corp.* v. *Insulating Concrete Corp.*, 153 F. Supp. 626 (D. Md. 1957); *Emerson* v. *National Cylinder Gas Co.*, 135 F. Supp. 268 (D. Mass. 1955).

The court's decision in the *Emerson* case was based on a set of facts quite similar to the one in the instant case. The court stated:

> Plaintiff's drawings submitted as part of his application for patent 741 showed tube 49, but his claim, instead of describing it as a tube, described it as "means within the casing defining a duct." The patent office rejected this specification as "not readable." This was, of course, technically correct. But if this was, as I hold it could be, a purely mechanical difference of no functional importance, and the rejection was not made because of any difficulty or objection of substance, such as lack of invention, infringement, or double patenting, it was a purely formal matter, and plaintiff's amendment substituting the words "a tube" for the seven words above quoted did not raise an estoppel against thereafter asserting equivalence in a matter of substance. Reece Button-Hole Mach. Co. v. Globe Button-Hole Mach. Co., 1 Cir., 61 F. 958. Therefore it could be found that defendants infringed patent 741, unless that patent is invalid. 135 F. Supp. at 271.

The rejection of "not readable" meant that the claims had failed to distinctly point out the invention.

The court in the *Abington Textile* case had the following to say about the doctrine of file wrapper estoppel.

> The doctrine of file wrapper estoppel is basically an equitable one, when properly understood and applied. When an applicant faced with a prior art rejection pursuant to 35 U.S.C. §§ 102 or 103 limits his claims in order to overcome the prior art rejection, it is inequitable for him to later assert that his patent coverage is of the same scope as it potentially was prior to amending his application claims in the Patent Office. If he had not inserted certain limitations in his claims it is presumed that the claimed subject matter would have been anticipated by, or obvious in view of, the cited prior art references. The same considerations do not apply to rejections other than prior art rejections, e.g., a rejection for undue *breadth of claims*. 249 F. Supp. at 842 (emphasis added)

The rejection in the instant case was similar to a rejection for "undue breadth of claims."

The court in *Ritter* v. *Rohm & Haas Co.*, 154 U.S.P.Q. 518 (S.D. N.Y. 1967) chose to apply the doctrine where the rejection was for indefiniteness.

The First Circuit has stated that there "is no real conflict, except linguistic" between these decisions. *Borg-Warner Corp.* v. *Paragon Gear Works, Inc.*, 355 F.2d 400 (1st Cir. 1965) writ of certiorari filed March 23, 1966, dismissed May 13, 1966. However, it did not offer any concrete suggestions for reconciling these opinions. What's more, it did not apply the doctrine of file wrapper estoppel even though the rejection of the Patent Office was for indefiniteness. The court stated:

> Review of the file wrapper as a whole discloses that

> the examiner's objection was that amounts were not indicated at all, i.e., that the invention was described only in terms of function. See fn. 8, supra. Hence when Seavey furnished details, although he was necessarily incorporating limitations, he gave up only an undescribed device. In these circumstances by asserting equivalence the plaintiff is not seeking to recapture what had been abandoned, because nothing having been previously stated, nothing had been abandoned. *The claims in other words, stand as claims initially made, entitled to the ordinary range of equivalents* . . . 355 F.2d at 406.

Applying this rationale here would result in a decision which would be contrary to the one reached by the Sixth Circuit Court of Appeals.

CONCLUSION

There is a real need for a decision of the Supreme Court on this issue. The question of whether the doctrine of equivalents is applicable in an infringement action arises very frequently since literal infringement is "a dull and very rare type of infringement." *Graver Tank Mfg. Co., supra* at 608. This determination is dependent on whether the doctrine of file wrapper estoppel is applicable. The application of this doctrine has not been harmonious among the courts. As a result, both the patentee and the public find themselves in a dilemma when they are confronted with the question of whether a patent whose claims were amended is being infringed. As a recent writer states:

> Hopefully, the Supreme Court will some day clarify the doctrine of file-wrapper estoppel, so that an applicant will be in a position to know in what situations he can safely rely on the doctrine of equivalents. *The*

Law of Chemical, Metallurgical and Pharmaceutical Patents, (page 371, Central Book Co., Inc. 1967).

Respectfully submitted,

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February, 1968.

APPENDIX A

OPINION BELOW

UNITED STATES COURT OF APPEALS
For The Sixth Circuit

Nos. 17407-08

BALLANTYNE INSTRUMENTS & ELECTRONICS, INC.,
Plaintiff-Appellee and Cross-Appellant,
v.
CHESTER WAGNER, an individual, and HENNY PENNY CORPORATION,
Defendants-Appellants and Cross-Appellees.

Appeal From the United States District Court for the Southern District of Ohio, Western Division

(Decided December 6, 1967.)

Before WEICK, Chief Judge, and PHILLIPS and CELEBREZZE, Circuit Judges.

PER CURIAM. This is a declaratory judgment action brought by Ballantyne Instruments & Electronics, Inc., (Ballantyne) against Chester Wagner and Henny Penny

Corporation, seeking to have Wagner's U. S. Patent No. 2,778,736 declared invalid. The three claims of this patent involve methods of deep fat cooking of foods, particularly fried chicken, under pressure.

The District Court originally sustained Ballantyne's motion for a summary judgment, holding that each claim of the patent in suit was anticipated by a method of frying chicken disclosed by the book "Quantity Cookery," published more than a year before the filing of the application for the patent.

In our opinion on the former appeal, reported at 345 F.2d 671, this Court affirmed the action of the District Court in holding the first claim to be invalid but reversed as to claims two and three, remanding the case for the taking of evidence on issues of fact relating to these two claims. Reference is made to the former opinion of this Court, written by Judge Arthur M. Smith of the United States Court of Customs & Patent Appeals, for a detailed discussion of the three claims of the patent and the issues involved.

Upon remand the District Court heard evidence and concluded that claims two and three of the Wagner Patent are not anticipated by the Quantity Cookery publication or by any patent or combination of patents in the prior art and that the invention of these two claims would not have been obvious to those skilled in the art. In detailed findings of fact and conclusions of law District Judge Carl A. Weinman held: (1) that claims two and three of the Wagner patent are valid; and (2) that under the applicable law and facts these two claims have not been infringed by Ballantyne.

Ballantyne has appealed from the judgment of the District Court insofar as it holds that claims two and three of the patent in suit are valid. The original defendants

have appealed insofar as the judgment holds that Ballantyne has not infringed the patent.

In essence Ballantyne's method contemplates placing the food in the pressure cooker, piece by piece, and then closing the cooker. Claims two and three of the Wagner patent provide for the so-called two-step cooking method, whereby after the oil is heated to a certain temperature the food is immersed in the oil for two or three minutes until it is browned and then the cooker is closed. The District Court concluded that the Ballantyne method does not infringe the patent.

We hold that the findings of fact of the District Judge that there was no infringement are not clearly erroneous, Rule 52 (a), Fed. R. Civ. P., but to the contrary are supported by substantial evidence. We further hold that the District Judge was correct in ruling that there was no infringement and that claims two and three of the patent are valid upon the authorities set forth in his findings of fact and conclusions of law.

Affirmed.

APPENDIX B

December 6, 1967

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Re: Ballantyne Instruments & Electronics, Inc. vs. Chester Wagner and Henny Penny Corporation — Nos. 17,407-8

Gentlemen:

The Court today announced its decision in the above-entitled cases, affirming the judgment of the District Court.

A copy of the Court's opinion is enclosed, and judgments in conformity with the opinion have been entered today as required by Rule 21(4).

Yours very truly,

Carl W. Reuss, Clerk

Deputy Clerk